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EXAMINER

JOHNSON, BLAIR M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS R. DOMEL and WINSTON G. WALKER

Appeal 2009-004781
Application 10/062,655
Technology Center 3600

Decided: November 10, 2009

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Douglas R. Domel, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to “remotely-controlled window covering actuators.” Specification 1:3.

Claim 7, reproduced below, is illustrative of the subject matter on appeal.

7. A method for controlling a motorized window covering, comprising the acts of:
 - deactivating a data signal amplifier;
 - activating a wake-up signal amplifier; and
 - activating the data signal amplifier to process an IR or RF data signal to move the window covering only in response to an IR or RF wake-up signal being received by the wake-up signal amplifier, the wake up signal having a first frequency and the data signal having a second frequency different from the first frequency.

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Apr. 9, 2007) and Reply Brief (“Reply Br.,” filed Feb. 6, 2009), and the Examiner’s Answer (“Answer,” mailed Feb. 11, 2008).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

van Dinteren	5,909,093	Jun. 1, 1999
Buccola	6,486,793 B1	Nov. 26, 2002
Altrogge	DE 3438842 A1	May 22, 1986

The following rejection is before us for review:

1. Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over van Dinteren and, Buccola or Altrogge.

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over van Dinteren and, Buccola or Altrogge turns on whether one of ordinary skill in the art would have been led to arrive at the claimed subject matter given these references.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Van Dinteren relates to remotely controlled blind arrangements.

2. Van Dinteren discloses a remote control using IR and which includes a sleep mode (col. 5, ll. 43-61).
3. The Examiner states that at col. 5, l. 32 and ll. 43-61 van Dinteren discloses “a battery powered ... window covering which is manipulated by an IR remote control system and which is concerned with saving power and addresses this issue by providing a well known sleep mode for the receiver.”

Answer 3. This appears to be an accurate characterization of what van Dinteren discloses and the Appellants do not dispute it.

4. The Examiner states the following regarding the Buccola disclosure:

Buccola also discloses a remote control unit for actuating an operator, in this case a door lock. Buccola discloses an alternative means for saving battery power which serves his receiver system. Specifically, referencing Fig. 3 and column 4, lines 22-45, a series of amplifiers 36,42, precede passage of the signals to each of a separate low frequency detector and a high frequency detector, the low frequency detector signaling the wake-up circuit while the high frequency detector signals the data receiving circuit of the microprocessor. The presence of the two frequency detectors indicates that two signals are produced. The wake up signal saves power drain and “prepares”, i.e. wake up, the data receiver.

Answer 3. This appears to be an accurate characterization of what Buccola discloses and the Appellants do not dispute it.

5. The Examiner states that

DE 3438842 A1 also provides a system that uses two signals. His IR data signal is activated by an “additional receiver”. While ‘842 does not use an IR or RF emitter/receiver, he clearly discusses such in his discussion of the prior art and generally makes it known that he proposes a visible light signal as it provides certain improvements over the IR or RF.

Answer 3-4. This appears to be an accurate characterization of what Altrogge discloses and the Appellants do not dispute it.

Any differences between the claimed subject matter and the prior art

6. The claimed subject matter combines elements separately disclosed in the cited prior art.

The level of skill in the art

7. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of motorized window coverings and remote controls. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

8. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The Appellants argued claims 1-20 as a group (App. Br. 4). We select claim 1 as the representative claim for this group, and the remaining claims 2-20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007). We note the Appellants’ criticism that the Examiner did not treat claims 6, 7, 9, 15, 19, and 20. App. Br. 8 and

Reply Br. 4. We will address that after we analyze the Appellants' principle argument.

The Appellants' principle argument is that one of ordinary skill in the art would not have been led to combine the disclosures of van Dinteren and Buccola or Altrogge and arrive at the claimed subject matter.

The Examiner took the position that all the elements claimed were disclosed in the cited references. FF 1-5. There appears to be no dispute that that is the case.² There is,

[a] need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a "patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 415-416.

² We note that, in the Appeal Brief (p. 7), the Appellants did argue that the Examiner failed to address the amplifiers recited in claim 7. But that does not appear to be the case. It was addressed both in the Office action of Mar. 20, 2007 (p. 2) and the Answer (p. 3). The Examiner pointed to the amplifiers 36 and 42 in Fig. 3 of Buccola. FF 4. The associated disclosure at col. 4, ll. 23-57 discusses their operation.

“[W]hen a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR, 550 U.S. at 417.*

The Examiner found that the claimed subject matter unites elements disclosed in the cited references with no change in their respective function. Given that the Examiner’s determination that all the elements of the claimed subject matter are disclosed in the cited prior art and there is no evidence of that uniting the disclosed elements in the manner claimed yields an unpredictable result, a prima facie case of obviousness has been made out.

The Appellants would have us reverse the rejection on the grounds that (1) “Buccola is drawn to door locks; the door lock art is not analogous to the window covering art of the present claims [and of van Dinteren]” (App. Br. 4) and (2) “no suggestion exists to combine Buccola with van Dinteren. Nowhere does Buccola suggest using its principles in anything other than locking mechanisms ...” (App. Br. 5).

We are not persuaded by these arguments.

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658 (Fed.Cir.1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796

F.2d 436, 442 (Fed.Cir.1986); *see also In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979).

In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Here, Buccola is reasonably pertinent to the particular problem with which the inventor is involved - that problem being conserving power (*i.e.*, energy saving). As the Examiner pointed out (Answer 5), Buccola also seeks to save energy (*see col. 4, l. 42*: “... prevents the unnecessary drain of power ...”). Accordingly, we do not agree that Buccola is nonanalogous art.

As to there being no suggestions in the references to make the cited combination of references, to establish a *prima facie* case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. *See e.g., In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); *In re Johnston*, 435 F.3d 1381, 1385 (Fed. Cir. 2006) (“An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art”); and *In re Nilssen*, 851 F.2d 1401, 1403 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”). *See also KSR*, 550 U.S. at 419 (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”). Nevertheless the Examiner provided an explicit

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analysis with an apparent reason why one of ordinary skill in the art would combine the known elements of the prior art in the manner claimed. *See* Answer 3-4. The Examiner did not simply give mere conclusory statements but rather provided an apparent reasoning with logical underpinning to explain why one of ordinary skill in the art would combine the disclosures of the cited references and arrive at the claimed combination in support of a legal conclusion of obviousness. In our view, the Examiner has established a *prima facie* case of obviousness.

We understand the Appellants' concern that "[t]aken to what must be regarded as an unintended extreme, KSR would prevent patentability of any and all inventions that used old elements, which is to say, anything under the sun made by man." Reply Br. 3. But the Appellants themselves appear to recognize the distinction between this case and *KSR*. The Appellants correctly point out that the Court's holding was based on the *evidence* of record. Reply Br. 2. *KSR* does not prevent patentability of any and all inventions that used old elements where, for example, the evidence on record shows the combination yields an unpredictable result. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 550 U.S. at 418. The Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *Id.* (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known

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methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 1739. The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 1740. In that regard, there is no evidence on the record that the combination of the elements of the cited references yields anything but what one of ordinary skill would have predicted.

The Examiner established a *prima facie* case obviousness over the prior art, the characterization of which is not in dispute and supported by an articulated reasoning whose logical underpinning has not been challenged. To overcome the *prima facie* case of obviousness, it was incumbent on the Appellants to then show, for example, that the claimed combination yields an unpredictable result. Since there is no evidence on record of any secondary consideration of non-obviousness for our consideration (FF 8), the *prima facie* case of obviousness has not been overcome.

Regarding the Appellants’ criticism (App. Br. 8 and Reply Br. 4) that the Examiner did not treat claims 6, 7, 9, 15, 19, and 20, we would agree that the Office position could have been improved if the claims been treated individually. However, patents are “relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983). As for claim 7, *see* footnote 2 *supra*. As for claims 6, 9, and 15, which are directed to de-energizing/deactivating the data signal amplifier if a data signal has not been received within a “predetermined time period”, since the claim phrase “predetermined time period” is not

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specified, these claims reasonably broadly cover the eventuality that a data signal amplifier will deactivate/de-energize if no longer activated. That is, a condition Buccola's data signal amplifiers would inherently possess. *See* FF 4. As for using only a battery (claim 19), *see* col. 5, l. 32 of van Dinteren which describes the supply unit that drives the blind and which is said to be "preferably battery supplied". As for the battery being a "Lithium battery" (claim 19), such batteries are notoriously well known in the art and one of ordinary skill in the art reading van Dinteren would have considered using a known lithium battery as a battery for the supply unit.

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over van Dinteren and, Buccola or Altrogge.

DECISION

The decision of the Examiner to reject claims 1-20 is affirmed.

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AFFIRMED

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